Doc Code: AP.PRE.REQ

PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number (Optional) 1875.2050000

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]	Application Number	Filed
	10/087,779	March 5, 2002
on _____	First Named Inventor	
Signature_____	Thomas L. JOHNSON	
Typed or printed name _____	Art Unit 2616	Examiner Sefcheck, Gregory B.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
    Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☐ attorney or agent of record.
Registration number _____

☒ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____43,610_____

_____
Signature

Thomas C. Fiala
_____
Typed or printed name

(202) 371-2600
_____
Telephone number

November 15, 2006
_____
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☒ *Total of ____1____ forms are submitted.

609,547

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	Confirmation No.: 8819
JOHNSON *et al.*	Art Unit: 2616
Appl. No.: 10/087,779	Examiner: Sefcheck, Gregory B.
Filed: March 5, 2002	Atty. Docket: 1875.2050000
For: **Method, Apparatus and Computer Program Product for Performing Data Packet Classification**	

Arguments to Accompany the Pre-Appeal Brief Request for Review

Commissioner for Patents
PO Box 1450   *Mail Stop: AF*
Alexandria, VA 22313-1450

Sir:

Applicants hereby submit the following Arguments, in five (5) or less total pages, as attachment to the Pre-Appeal Brief Request for Review Form (PTO/SB/33). A Notice of Appeal is concurrently filed.

Arguments

Applicant's arguments in the Reply under 37 C.F.R. § 1.116, filed in response to the final Office Action issued June 22, 2006, were not properly considered or responded to by the Examiner in the Advisory Action issued October 3, 2006. In particular, the Examiner's response was legally and factually deficient because the Examiner failed to adequately show where the cited prior art teaches or suggests a network interface, computer program product or any other structure capable of generating a plurality of "program modules" as recited by the independent claims of the present application.

Claims 1, 14, 15 and 27 are the independent claims in this application. Independent claims 1, 14 and 15 each recite a method for classifying a data packet in a network interface that either includes the step of "generating a plurality of program modules, each of said plurality of program modules for testing for adherence to at least

- 2 -

JOHNSON *et al.*
Appl. No. 10/087,779

one corresponding classification parameter" as recited by claims 1 and 15, or the step of "generating a plurality of optimized program modules, each of said plurality of program modules for testing for adherence to at least one corresponding classification parameter" as recited by claim 14. Independent claim 27 recites a computer program product that includes "means for enabling [a] processor to generate a plurality of program modules, each of said plurality of program modules for testing for adherence to at least one corresponding classification parameter."

The Examiner has rejected each of independent claims 1, 14, 15 and 27 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,600,744 to Carr *et al.* ("Carr"). For a rejection to be legally adequate under 35 U.S.C. § 102, every claim limitation must be taught in a single reference. *Industries, Inc. v. Guardian Industries Corp.*, 75 F.3d 1558, 1566 (Fed. Cir. 1996). Because Carr does not teach or suggest any structure capable of "generating a plurality of program modules" as recited by the independent claims of the present application, the rejection of those claims as anticipated by Carr is improper. *Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 750 F.2d 1569, 1574 (Fed. Cir. 1984)(the absence of any claimed element from the reference negates anticipation).

1. *The Carr Reference*

Carr is directed to a method and apparatus for packet classification that stores "rules" or parameters for classifying the packets in a memory structure, such as a DRAM. *See* Carr, col. 2, ll. 32-33 ("The rules or parameters for classifying the packets are stored in a memory structure."). The purported benefits of storing the classification parameters in a memory structure include the ability to store a large number of parameter sets and easy modification and selection of the parameters for classification purposes.

- 3 -

JOHNSON *et al.*
Appl. No. 10/087,779

See Carr, col. 2, l. 57-col. 3, l. 4. Once the classification parameters have been selected, they are provided to a comparison block 50 that includes comparators that perform different types of comparisons between the selected classification parameters and information derived from the header of a packet (termed a "key"). *See* Carr, col. 7, ll. 26-28 ("The comparison block 50 illustrated in FIG. 2 includes comparators that perform different types of comparisons on the information in the key 24 and the rule 42."). Such comparison operations include a 5-bit equal compare, a 32-bit mask and compare, a 12-bit mask and compare, an 8-bit mask and range, and a 16-bit range. *See* Carr, col. 7, ll. 29-60, FIG. 2. According to Carr, the comparison block is preferably implemented in hardware. *See* Car, col. 12, ll. 9-11 ("Preferably, all the components illustrated in FIG. 3 are implemented on a single integrated circuit that is dedicated to performing packet classification operations.").

2. *Carr Does Not Teach or Suggest Any Structure Capable of Generating a Program Module as Recited by the Independent Claims*

In contrast to the teachings of Carr, the independent claims of the present application recite a network interface or a computer program product that is capable of generating "a program module" that tests "for adherence to at least one corresponding classification parameter" in a plurality of received classification parameters. As described in the specification of the present application:

> Primitive generator and test applicator 420 generates primitives (i.e., program modules) which are based on the classification parameters 403. The generated primitives (not shown in FIG. 4) are used to test the target data packet for compliance with the classification parameters 403 with which the primitives are associated.

See Specification at paragraph [0069]. Example operations performed by the program modules include mask and range and mask and compare operations. *See* Specification at paragraphs [0143]-[0159] and FIGS. 15A, 15B and 15C. The generation of program

modules as recited in the independent claims provides flexibility because the various testing operations that can be performed can be easily modified since the operations are defined in software. Moreover, the software modules can be executed in any order. *See* Specification at paragraph [0015] ("Further, the program modules of the present invention can be executed in any order. Thus, when randomly ordered classification criteria are encountered, the criteria does not have to be reordered.").

Carr must fail as an anticipatory reference because there is simply no structure disclosed in that reference that is capable of generating program modules as recited by the independent claims of the present application. The structure in Carr that is most similar to the recited program module is comparison block 50, which performs different types of comparisons between selected classification parameters and information derived from the header of a packet. However, Carr does not teach or suggest a network interface, computer program product, or any other structure that is capable of "generating" comparison block 50—rather, comparison block 50 is presumably designed prior to implementation of Carr's system and is fixed during operation.

Despite this shortcoming of Carr, the Examiner has made several arguments to support the rejection of the independent claims of the present application over Carr. In the final Office Action issued June 22, 2006, the Examiner argued that although Carr's preferred embodiment is implemented in hardware, the teachings of Carr are nevertheless relevant because (1) the recited "program modules" could be construed to cover hardware and (2) "it is well-known to one of ordinary skill in the art that hardware functionality and processes can be implemented through software based upon the requirements of the system." In the advisory action issued October 3, 2006, the Examiner further argued that Carr in fact suggests that the components described therein

- 5 -

JOHNSON *et al.*
Appl. No. 10/087,779

could be controlled or implemented in software. Applicants strongly disagree with each of these assertions. However, even if each of these assertions were true, and Carr's comparison block 50 could be considered a "program module" within the meaning of independent claims 1, 14, 15 and 27, Carr still fails to teach or suggest the <u>generation</u> of comparison block 50 by a network interface, computer program product, or any other structure as recited by the independent claims of the present application
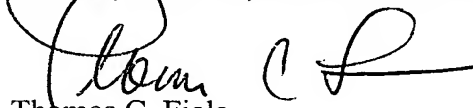
3.   *Conclusion*

In view of the foregoing, Applicant respectfully requests reconsideration and withdrawal of the rejection of independent claims 1, 14, 15 and 27 under 35 U.S.C. § 102(e) over Carr. The rejection of dependent claims 2-13, 16-26, and 28-39 of the present application is also premised on the improper assertion that Carr teaches or suggests a structure that generates "program modules". Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of those claims as well.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

Thomas C. Fiala
Attorney for Applicant
Registration No. 43,610

Date: 11/15/06

1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600

609000_1.DOC